

REMARKS

Claims 29 through 39 are presently pending herein. Claims 29 and 36 are presented in independent form. The rejection of these claims was not sustained on appeal. As noted in 37 CFR 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, *and then only for the consideration of matters not already adjudicated, sufficient cause being shown.* (emphasis added)

It is unclear just what was the basis for reopening prosecution of claims 29-39. The decision of the Board of Appeals did not indicate that further search was needed, (1211.04 Remand by Board for Further Search) nor did the Board decision indicate a new grounds of rejection (37 CFR §§41.50 Decisions and other actions by the Board).

Yet the examiner embarked on an extensive search and reprosecution of the application instead of following the standard practice as clearly stated in the Manual of Patent Examining Procedure (MPEP) identified below:

1214.04 Examiner Reversed

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

The resulting effect is that the Applicants have been prejudiced by the delay due to this piecemeal prosecution which does not follow standard office procedure and is clearly arbitrary and capricious. Applicants request that the Office Action date July 2, 2008 be withdrawn and the application passed to issue without delay

Applicants' invention, as recited in Claim 29, is directed to a method to determine configuration information associated with an optical network having a plurality of optical nodes coupled by optical fiber spans. The method comprises the steps of: (i) exchanging identification messages between neighboring nodes, each identification message including a source node identifier and node configuration data; (ii) *for each node, publishing the identity of the node, the identity of its neighbors*, and the node configuration data associated with the node; and (iii) determining a network configuration consistent with the published node information.

In the present office action, Claim 29 is now rejected by Robidas et al. either alone or in combination with the Moy document. (Although the examiner has provided a date of July 1977 for the Moy document, there is no evidence that this document was published on that date or any other date prior to Applicants' filing date. Thus the examiner has failed to provide a prima facie case of obviousness.) The Robidas et al. published patent application fails to meet the limitations of Claim 29. The paragraphs noted in the office action, i.e. paragraphs [0042] to [0045] do not describe any of the limitations of Claim 29. In paragraph [0044] Robidas et al. states that "[T]he SMC's Trunk Manager discovers its neighbors connected to each of its trunks and notifies Optical Routing of these *trunks*. Peer discovery involves having a node send its optical routing parameters and trunk identification over the in-band channel to its neighbor." (emphasis added) Robidas does not disclose that the peer discovery parameters are ever sent and therefore does not disclose "exchanging identification messages between nodes", nor does Robidas disclose "*for each node, publishing the identity of the node, the identity of its neighbors*, and the node configuration data associated with the node" nor does Robidas et al. disclose "determining a network configuration consistent with the published node information." Robidas et al. simply does not disclose the method steps of Claim 29. Moy, even if it could be

shown to be prior art, does cure the deficiencies of Robidas et al. Contrary to the office action's assertion in regard to link state advisement (LSA) on page 9 of Moy, there is no indication on page 9 that LSA contains neighbor information.

With regard to the rejection of Claims 29 and 30 as being unpatentable over deVette in view of Obeda et al., it should be noted that on appeal, the Board had before it the patent of Elliot which was used in combination with deVette to reject other claims on the basis that Elliot taught bi-directional communication, yet the Board did not apply a new ground of rejection of Claim 29 based upon a combination of deVette and Elliot. Thus, the Board found that deVette failed to disclose *exchanging* information between neighboring nodes. It would not have been obvious to modify deVette to provide the exchange of information between neighboring nodes simply by adding bi-directional communication in view of Obeda.

With regard to the rejection of Claims 32 and 33 as being unpatentable over deVette in view of Obeda et al. and further in view of Au et al., the patent of Au et al. does not state that "the node configuration data includes a node setting" and that "the alarm signal is an incompatible node setting alarm signal" as required by Claim 32, nor does Au et al. disclose "a node parameter associated with the network configuration" and "the alarm signal is an incompatible node parameter alarm signal" as required by Claim 33. There is no specificity in Au et al., but only generalizations about determining node compatibility. The combination of references does not teach specifically node settings, node parameters or signals specific to specific types of incompatibility.

The rejection of Claims 30-31 and 34 depend from Claim 29 and, therefore, are allowable for at least the reasons that Claim 29 is allowable. Furthermore, the rejection based on Robidas, et al. in view of Moy and further in view of Lang et al. and Obeda is purely based on hindsight.

Further, the document of Lang et al. while bearing the notation “Expiration date: September 2001: also bears the notation “Internet Draft”. There is no indication that the document was actually published on September 2001 or any date prior to Applicants’ filing date of February 6, 2002. Lang et al. is not specific as to what is meant by “protection definitions” or that those definitions include “incompatible node protection type” as recited in Claim 31 or “node setting” as recited in Claim 32 or “node parameter” as recited in Claim 33. Simply put, Lang et al. does not define what is meant by “protection definitions” and cannot meet the claim language. Obeda et al. does not disclose the specific alarm signal which is specifically claimed. Obeda et al. in col. 7 only refers to alarms generally, but does not teach the specific claim language. Furthermore, it would not have been obvious to combine the disclosures to meet the specific language of the claims.

The rejection of Claims 31 and 34 depend from Claim 29 and, therefore, are allowable for at least the reasons that Claim 29 is allowable. Furthermore, the rejection based on deVette in view of Obeda and further in view of Lang et al. is purely based on hindsight. Further, the document of Lang et al. while bearing the notation “Expiration date: September 2001: also bears the notation “Internet Draft”. There is no indication that the document was actually published on September 2001 or any date prior to Applicants’ filing date of February 6, 2002. Lang et al. is not specific as to what is meant by “protection definitions” or that those definitions include “incompatible node protection type” as recited in Claim 31 or “node setting” as recited in Claim 32 or “node parameter” as recited in Claim 33. Simply put, Lang et al. does not define what is meant by “protection definitions” and cannot meet the claim language. With regard to Claim 34, Lang et al. does not even discuss “incorrectly connected fibers” as required by the claim and therefore is inapplicable to Claim 34. Obeda et al. does not disclose the specific alarm signal

which is specifically claimed. Obeda et al. in col. 7 only refers to alarms generally, but does not teach the specific claim language. Furthermore, it would not have been obvious to combine the disclosures to meet the specific language of the claims.

With regard to the rejection of claim 35 as being unpatentable over Robidas et al. and Moy and further in view of Battou et al., Claim 35 is dependant on Claim 29 and is patentable for the same reasons as Claim 29 and also in that there is no reasonable basis for the combination of references to meet the claimed invention since Battou et al. does not disclose issuing an error correction responsive to determining that the network configuration differs from a planned configuration. Claim 29 requires that the network configuration is obtained from the published node information. This is not disclosed by Battou et al.

Applicants' invention, as recited in Claim 36, is directed to an optical node for a optical network. The optical node comprises an optical transport complex for adding, dropping, and passing through optical channels; an administrative complex for administering the optical transport complex and having a memory adapted to receive provisioning data for the optical transport complex; an inter-node communication module coupled to the administrative complex for communicating with neighboring nodes on an inter-node data channel and publishing data to the optical network; and a configuration discovery module exchanging node identification and configuration data with other nodes to determine the network configuration.

Claim 36 has been rejected based upon the combination of Chaudhuri et al. in view of Moy. The deficiencies of Moy have been discussed above and are incorporated herein by reference. The patent of Chaudhuri et al. discloses a mediation device to provide an interface between external sources and the OLXC. Chaudhuri does not disclose that the mediation device administers the optical transport complex and has a memory adapted to receive provisioning

data. Furthermore, the discounting of the claimed internode module and configuration discovery module without the application of any prior teaching should be withdrawn. For these reasons, the rejection of Claim 36 based on Chaudhuri et al and Moy must be withdrawn.

Claims 37 to 39 depend from Claim 36 and, therefore, are allowable for at least the reasons that Claim 36 is allowable. Furthermore, there is no reasonable basis for the combination of Chaudhuri et al., Moy, Lau et al. and Obada absent hindsight.

Applicants respectfully submit that the subject patent application is in condition for allowance. This amendment is being submitted with a request for a two month extension of time and a check in the amount of \$490.00. It is believed that no additional fees are due. However, should that determination be incorrect, the Commissioner is hereby authorized to charge any deficiencies to Deposit Account No. 50-0562 and notify the undersigned in due course.

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Respectfully submitted,



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